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EXAMINER	
UTAMA, ROBERT J	

ART UNIT	PAPER NUMBER
3715	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/804,806	KREBS ET AL.	
	Examiner	Art Unit	
	ROBERT J. UTAMA	3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-14,16-20,22-24 and 26-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-14, 16-20, 22-24, 26-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the application

1. This office action is a response to the amendment and arguments submitted on 06/18/2010. The current statuses of the claim in the application are as follows: claims 12-14, 16-20, 22-24, 26-30 are still pending and claims 1-11, 15, 21 and 25 have been cancelled.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 22-24, 26-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 22-24 and 26-30 the claim are rejected since the specification does not exclude transitory medium. The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuitjen,* 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter). A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C.§101 by adding the limitation "non-transitory" to the claim.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 14 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 24 and 14 set forth the negative limitation of disallowing the allocation of the third function provided by the authoring tools to the instructional design role and disallowing the allocation of the fourth set of function, provided by the authoring tool to the content definition role. Any negative limitation or exclusionary proviso must have basis in the original disclosure. In this particular case, the specification provided fails to show any support to the negative limitation.

7. Claims 14 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 24 and 14 set forth the negative limitation of disallowing the allocation of the third function provided by the authoring tools to the instructional design role and disallowing the allocation of the fourth set of function, provided by the authoring tool to the content definition role. In this particular case, the specification fails to provide any enablement to use or make the invention

as claim. The specification is not clear the type of function and the mechanism that would be disallowed in the instructional design role and content definition role.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 12-14 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Baffes et al US 6,292,792.**

Claims 12 and 22: The Baffes reference provides a teaching of a computer-implemented method to configure an authoring tool to author a computer-based training course (see Baffes abstract):

storing in a computer device sets of allocation data wherein each of the sets allodcation data correspond to a different respective of functions of an authoring tools (see col. 21:60-40);

wherein each of the sets of allocation data includes allocation setting with each correspond to a different one of an instructional design role (see FIG 30 col. 21:30-45) and content definition role (see FIG 36 col. 23:45-65) wherein the instructional design role and the content definition role are each for the user to assume with respect to the authoring tools; each of the allocation settings specifying a respective ability to customize an allocation of the function which correspond to the set of allocation to the role which correspond to the allocation setting (see col. 17:5-20).

Receiving an indication of a selection by the user of one of the instructional design role and the content definition role (see col. 21:45-50);

In response to the received indication of the role selection, the computer generating based on the allocation settings of the set of allocation data, a list of one or more function in the set of available to be selected for allocation to one or more functions in the set of function available to be selected for allocation to the one of the instructional design role and content design role (see FIG 29 col. "concept editor" and "pedagogy editor");

presenting to the user the list of one or more functions in the set of function (see col. 18:19-30);

Receiving an indication of a selection by the user of one of the one or more presented functions; and in response to the received indication of the function selections, allocating the selected function to the selected role (see col. 23:35-45).

Claims 13 and 23: The Baffes reference provides a teaching wherein allocating the selected function to the selected role includes one of allocating a first default set of instructional design functions to the instructional design role (see FIG 30 col. 21:30-45) and allocating a second set of content definition function to the content definition role (see FIG 36 col. 23:45-65).

Claims 14 and 24: The Baffes reference provides a teaching wherein allocating the third function to the selected role includes one of preventing the allocation of a third set of function, provided by the authoring tools to the instructional design role (see col. 20:60-65) and preventing the allocation of a fourth set of function provided by the authoring tool to the content definition role (see col. 24:5-15).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. **Claims 16-20 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baffes et al US 6,292,792 in view of US Hekmatpour US 5,644,686**

Claims 16 and 26: The Baffles reference fails to provides a teaching wherein the presenting the list of one or more functions in the set of functions includes presenting in a first distinct display area a list of functions for selective allocations to only one of the instructional design role and content definition role, the method further comprising presenting in a second display area a second list of one or more functions in the set in the set of functions for selective allocation to only the other of the instructional design role and a content definition role, the displaying in the distinct first and second display in conjunction with a graphical user-selection mechanism so as to facilitate graphical selection of the first and second of functions by a user. The Hekmatpour provides a teaching of a teaching wherein the presenting the list of one or more functions in the set of functions includes presenting in a first distinct display area a list of functions for selective allocations to only one of the instructional design role and content definition role, the method further comprising presenting in a second display area a second list of one or more functions in the set in the set of functions for selective allocation to only the other of the instructional design role and a content definition role, the displaying in the distinct first and second display in conjunction with a graphical user-selection mechanism so as to facilitate graphical selection of the first and second of functions by a user (see FIG 15 and col. 22:10-30). It has been previously held that the use of known technique to improve similar devices (methods, or products) in the same way is a valid rationale to support an obviousness rationale. In this particular case, the Hekmatpour reference provides a teaching of displaying different function in different areas of the screen. One of ordinary skilled in the art would have been motivated to include the teaching of Hekmatpour multiple window in the teaching of Baffes since it allows for an efficient use of the display screen.

Claims 17 and 27: The Baffes reference provides at teaching of wherein the first and second display areas comprises of window presented within a graphical user interface and the graphical user selection mechanism is a collection of check boxes (see FIG 20).

Claims 18 and 28: The Baffes reference fails to provide a teaching customizing a display of function to the user based on the user the role which the user has been located and the functions allocated to the user's role. However, the Hekmatpour reference provides a teaching of customizing a display of function to the user based on the user the role which the user has been located and the functions allocated to the user's role (see col. 22:25-30). It has been previously held that the use of known technique to improve similar devices (methods, or products) in the same way is a valid rationale to support an obviousness rationale. In this particular case, the Hekmatpour reference provides a teaching of allowing the user to costumizes the user interface. One of ordinary skilled in the art would have been motivated to include the teaching of Hekmatpour costumizable window in the teaching of Baffes since it allows for an efficient use of the display screen.

Claims 19 and 29: The Baffes reference provides a teaching of the display of function by selectively displaying user-selectable indicia only for the functions allocated to the user's role (see col. 24:12-15 selecting the pedagogy generator allow the display of the generator).

Claims 20 and 30: The Baffes reference provides a teaching wherein the user-selectable indicia within the at least one of drop-down menu (FIG 20 item 156).

Response to Arguments

12. Applicant's arguments filed 06/18/2010 have been fully considered but they are not persuasive.

13. Applicant's amendment on claims 12-14, 16-20 are sufficient to overcome the rejection under 35 U.S.C 101. As such, the rejections on these claims have been withdrawn.

14.

15. With respect to applicant's argument and amendment on claims 22-24 and 26-30; a broad interpretation of the term "a machine readable storage medium" does not exclude transitory media. The applicant's specification also fails to exclude a transitory media from the term "a machine readable storage medium". As such, the examiner takes the position that rejection on claims 22-24 and 26-30 are still warranted and maintained. A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C.§101 by adding the limitation "non-transitory" to the claim.

16. With respect to applicant's argument on claims 14 and 24; the applicant argues that the paragraph 45 of the specification provides a teaching of "allocating the third function to the selected role includes one of preventing the allocation of a third set of function, provided by the authoring tools to the instructional design role preventing the allocation of a fourth set of function provided by the authoring tool to the content definition." However, the specification provided fails to provide a teaching of a third and fourth function that prevent the allocation of some other function. As such, the examiner takes the position that the rejection are still warranted and still maintained.

17. With respect to the applicant's argument that the Baffes reference do not provides a teaching for an instructional design role and content definition role. However, the applicant has not shown how the concept editor and pedagogy editor are different from the instructional and content design role.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. UTAMA whose telephone number is (571)272-1676. The examiner can normally be reached on 9-5:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. J. U./
Examiner, Art Unit 3715

/XUAN M. THAI/
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